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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT PAPER NUMBER

2134

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,273

Applicant(s)

MATSUYAMA ET AL.

Examiner

Michael J. Simitoski

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,8,9,18,19,22,23,26 and 27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1-3,10-17,24,25 and 29 is/are rejected.
- 7) ☒ Claim(s) 6,7,20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20061027</u> .                           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                          |

### **DETAILED ACTION**

1. The response of 8/22/2006 was received and considered.
2. Claims 1-29 are pending.
3. Claims 4-5, 8-9, 18-19, 22-23 & 26-27 are withdrawn and therefore, claims 1-3, 6-7, 10-17, 20-21, 24-25 & 28-29 are examined herein. See attached interview summary for explanation of claims 26-27 being withdrawn.
4. Claims 6-7 & 20-21 are objected to.
5. Claim 28 is allowed.
6. Claims 1-3, 10-17, 24-25 & 29 are rejected.

### ***Election/Restrictions***

7. Claims 4-5, 8-9, 18-19 & 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Further, as per the interview summary attached to this office action, claims 26-27 are withdrawn as belonging to a non-elected species. Election was made **without** traverse in the reply filed on 8/22/2006 and confirmed on 10/27/2006. Because applicant did not distinctly and specifically point out any supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Response to Arguments***

8. Applicant's arguments filed 5/30/2006 have been fully considered but they are not persuasive.

Art Unit: 2134

9. Applicant's response (p. 11, ¶2) argue that because Ginter mentions that "an office 210 may ... permit only specified employees and/or groups to access certain information", Ginter purposely chose that an authentication would not be performed. Applicant's response argues that there is no motivation to combine the teachings of Moreh and Ginter, in order to create a feature that Ginter appears to have rejected. However, it is first noted that Ginter not only envisions including in the permissions a group of users to allow access, but also or alternatively, single users (col. 165, lines 55-64). This is done because the PPE implementing the virtual distribution environment will enforce the permissions and only allow access of a user to a particular object whose name is in the access control list for the particular object. Further, Moreh teaches that a system where messages are accompanied by an access control list (Fig. 6, #84 & col. 9, lines 31-60). A user is authenticated to provide security for the messages (col. 4, line 66 – col. 5, line 7), where the authentication is based on certificates identified in the list (col. 7, lines 39-47 & col. 9, lines 58-60). It is clear from the Moreh reference that one having ordinary skill in the art would have been motivated to modify Ginter to authenticate the user based on a digital certificate, as taught by Moreh. The motivation provided by Moreh is to provide greater security, i.e. rather than blindly admitting a user, the user must present a certificate to first authenticate the user (as is known in the art to ensure the user is who he/she claims to be).

10. Applicant's response (p. 11) argues that Ginter fails to teach performing such authentication "even after specifically envisioning setting up a group of permitted users and applicant argues that "one skilled in the art reading Ginter would understand that not performing such authentication was a purposeful choice". However, lack of disclosure of a limitation does not in any way suggest that there is a teaching away from a limitation. In such a view, nothing

Art Unit: 2134

would ever be obvious over a given reference. Further, applicant argues that Ginter teaches away from Moreh because the feature of authenticating the user based on the certificate is a "feature that Ginter appears to have rejected". However, no evidence is given that Ginter has rejected this feature. Again, simply because Ginter has not disclosed this feature does not mean that the feature has been rejected.

11. Applicant's response (p. 11) requests that the Examiner point to specific portions of Ginter that provide the requisite motivation. However, no requirement exists that the Ginter reference provide motivation. The MPEP §2143.01 states:

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Therefore, the Examiner directs applicant to the above-stated motivation in Moreh for authenticating Ginter's user in accordance with an identified certificate.

12. Further, the Khidekel reference is applied. Khidekel is cited for teaching identification certificates and the benefits of using identification certificates over standard public key certificates.

***Specification***

13. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: CONTENT DISTRIBUTION SYSTEM  
AUTHENTICATING A USER BASED ON AN IDENTIFICATION CERTIFICATE  
IDENTIFIED IN A SECURE CONTAINER.

***Claim Objections***

14. Claims 2-3, 6-7, 10-14, 16-17, 20-21 & 24-25 are objected to because of the following informalities: In each claim, the claim refers to "Claim. X"; these should be replaced with "Claim X" without the "." after the word "Claim". Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter..

a. Regarding claim 29, the claim is directed to a medium, which according to the specification, p. 16, ¶3, could be a transmission medium such as a network. Such a transmission medium, as opposed to the storage medium also disclosed on p. 16, ¶3, does not fall within one of the statutory classes of invention. This claim could fall within one of the statutory classes if amended to clarify that the medium is a storage medium.

Art Unit: 2134

b. Regarding claim 29, even if the medium of the claim was a storage medium, there still appears to be no functional interrelationship between the medium and the user device. This could be overcome by clarifying that the computer program comprises instructions that are executed by a processor on the user device. While instructions are not disclosed explicitly in the specification, one of ordinary skill in the art understands that a computer program is a series of at least one instruction that is executed on a processor.

***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

c. Regarding claim 29, it is unclear how a program can comprise method steps. However, this rejection could be overcome by clarifying that the program comprises instructions which when executed on a processor of the user device, perform the steps that following in the claim. While instructions are not disclosed explicitly in the specification, one of ordinary skill in the art understands that a computer program is a series of at least one instruction that is executed on a processor.

***Claim Rejections - 35 USC § 103***

Art Unit: 2134

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-3, 10, 12, 15, 26 & 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,892,900 to Ginter et al. (**Ginter**) in view of U.S. Patent 6,158,007 to Moreh et al. (**Moreh**) and U.S. Patent 6,636,975 to Khidekel et al. (**Khidekel**).

Regarding claims 1-2, 10, 12, 15-16, 24, 26 & 29, Ginter discloses a certificate issued by an identification authority/trustworthy entity (col. 210, lines 31-45), container information/container in which a content transaction condition/use rights (col. 55, lines 1-11) is set including an identification certificate identifier list/specified employee (col. 55, lines 21-23) associated with said certificate (col. 212, lines 1-16), a content key for enciphering a content (col. 223, lines 5-11), a secure container (col. 59, lines 8-15 & col. 134, lines 29-58) including the content enciphered with the content key and said container information (col. 59, lines 8-47), a content distributor for distributing the content by moving said secure container (Fig. 2, #102 & 106), at least one user device/SPU for transacting the content with said content distributor (col. 60, lines 7-16), whereby user authentication is performed (col. 212, lines 1-16). Ginter is silent regarding authentication being performed in accordance with an identification certificate identified on the basis of the identification certificate identifier list when said secure container is moved, so that the content usable on said user device is distributed with content transaction managed. However, Khidekel is cited for teaching identification certificates (col. 3, lines 50-54), where the certificate is created by a trusted entity/certificate authority (col. 3, lines 50-54) and



Art Unit: 2134

contains a template serving as identification data/authentication information serving as identification data of a user (col. 4, lines 15-18) receiving a content (col. 6, lines 4-5), said template including at least one piece of personal biotic information/fingerprint (col. 4, line 63) and non-biotic information/identification information (col. 5, line 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to employ an identification certificate and the procedure to authenticate a user based on it, as described by Khidekel. One of ordinary skill in the art would have been motivated to perform such a modification to alleviate the problems with standard certificates, as taught by Khidekel (col. 2, lines 1-3, col. 3, lines 50-54, col. 4, lines 15-18, col. 5, line 1 & col. 6, lines 4-5).

Further, Moreh discloses messages accompanied with a list/access control list (Fig. 6, #84 & col. 9, lines 31-60), where authentication of a user is performed based on certificates identified in the list (col. 7, lines 39-47 & col. 9, lines 58-60) to provide security for messages between users on a computer network (col. 4, line 66 – col. 5, line 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to explicitly authenticate the user identified in the rights condition using the user's identification certificate.

One of ordinary skill in the art would have been motivated to perform such a modification to provide additional security for Ginter's secure containers transferred between users on a computer network, as taught by Moreh (Fig. 6, #84, col. 4, line 66 – col. 5, line 7, col. 7, lines 39-47 & col. 9, lines 31-60, col. 7, lines 39-47). While claim 29 is rejected under similar rationale as the other independent claims, it should be noted that claim 29 is broader in scope and one having ordinary skill in the art will be able to see how the rejection of, for example claim 1, also applies to claim 29.

Regarding claims 3 & 17, Ginter discloses the container information including data in which the condition of secondary distribution is set (col. 59, lines 42-48).

21. Claims 11 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter, Moreh & Khidekel**, as applied to claims 1 & 15 above, in further view of “IBM Cryptolopes, SuperDistribution and Digital Rights Management” by **Kaplan**. Ginter lacks explicitly storing a signature. However, Kaplan discloses that including a signature in a cryptographic container allows the user to authenticate its contents (p. 5, ¶2-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include a signature in the container. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate its contents, as taught by Kaplan (p. 5, ¶2-3).

22. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter, Moreh & Khidekel**, as applied to claim 1 above, in further view of U.S. Patent 5,949,877 to Traw et al. (**Traw**). Ginter, as modified above, lacks user devices authenticating one another when data are transmitted between them, and a data-transmitting user device generating a digital signature to data to be transmitted and a data-receiving user device verifying the digital signature. However, Traw teaches that to protect content from copying or misuse (col. 1, lines 40-48), each device authenticates the other devices (col. 6, lines 63-65) by generating a digital signature which is to be verified by the receiving device (col. 7, lines 5-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include user devices authenticating one another when data are transmitted between them, and a

Art Unit: 2134

data-transmitting user device generating a digital signature to data to be transmitted and a data-receiving user device verifying the digital signature. One of ordinary skill in the art would have been motivated to perform such a modification to protect content from copying or misuse, as taught by Traw (col. 1, lines 40-48, col. 6, lines 63-65 & col. 7, lines 5-35).

23. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter, Moreh & Khidekel**, as applied to claim 1 above, in further view of U.S. Patent 5,534,855 to Shockley et al. (**Shockley**). Ginter, as best understood, lacks the template/certificate including at least one piece of information selected from among personal biotic information including fingerprint information, retina pattern information, iris pattern information, voice print information, and handwriting information and a non-biotic information including a seal, a passport, a drivers license, and a identification card or any combination of the biotic and non-biotic information and a password. However, Shockley teaches that to guard against probing and user penetration, computer systems authenticate the identity of a user with biometrics (col. 1, lines 40-48), which are integrity locked into a certificate along with, for example, the user's public key (col. 5, lines 48-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ginter to include biotic data into the certificate (from Moreh). One of ordinary skill in the art would have been motivated to perform such a modification to guard against probing and user penetration by authenticating the identity of a user with biometrics, as taught by Shockley (col. 1, lines 40-48 & col. 5, lines 48-58).

*Allowable Subject Matter*

Art Unit: 2134

24. Claim 28 is allowed.

25. Claims 6-7 & 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

d. Regarding claims 6-7 & 20-21, the prior art relied upon fails to teach or suggest wherein said user device receiving said secure container authenticates a user thereof by comparing the template contained in the identification certificate identified on the basis of the identification certificate identifier list with sampling information input by the user and subsequently informing the service provider of the user authentication result, in combination with the other elements of the claims.

e. Regarding claim 28, the prior art relied upon fails to teach or suggest an information processing apparatus for receiving content by moving a secure container, comprising a section for performing user authentication through comparing the template contained in the identification certificated identified on the basis of the identification certificate identifier list with sampling information input by a user thereof and a section for informing a secure container distributor of the user authentication, in combination with the other elements of the claim.

### ***Double Patenting***

26. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

Art Unit: 2134

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

27. Claims 1, 15, 28 & 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 19, 28 & 30, respectively, of copending Application No. 09/943,773. The correspondence between claim 1 of the instant application and claim 1 of the '773 application are discussed below. The correspondence between the other claims listed above are believed to be analogous and as such are not explicitly discussed for brevity. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '773 application recites an identification certificate issued (IDC in the '773 application) containing a template serving as identification data of a user receiving a content, said template including at least one piece of personal biotic or personal non-biotic (personal identification data) information, containing information in which a content transaction condition is set including an identification certificate identifier list (IDC identifier list) associated with said identification certificate (wherein the container ...), a content key for enciphering content (second limitation), a secure container including the content enciphered with the content key and said container information (second limitation), a content distributor (secure container distributor device) for distributing the content, at least one user

Art Unit: 2134

device for transacting the content with said content distributor (first limitation), whereby user authentication is performed in accordance with the identification certificate identified on the basis of the identification certificate identifier list when said secure container is moved, so that the content usable on said user device is distributed with the content transaction managed (last two limitations). The '773 application lacks the content being moved, however, this is obvious to allow the actual transferal of ownership, as is well known in the art. Further, the '773 lacks the certificate issued by an authority. However, this is well known in the art to establish trust and hence is an obvious variation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

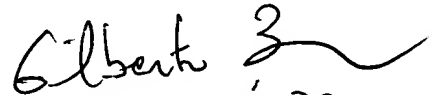
Art Unit: 2134

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MJS



October 27, 2006



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